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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,317	06/23/2006	Yoshihiro Okada	292829US0PCT	9081

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

BADR, HAMID R

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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11/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/584,317	Applicant(s) OKADA ET AL.	
	Examiner HAMID R. BADR	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/10/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' amendment filed 9/10/2009 is acknowledged.

The typographical error in the number of the patent to Jodlbauer has been corrected.

Claim rejections under 35 U.S.C 112 second paragraph is withdrawn due to the cancellation of claims 1-4.

Claims 5-19 are being considered on the merits.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the specification supports using germinated wheat , barley, oats and rye, there is no support for using barley malt at 10% or more level as recited in claim 5. Second embodiment in the specification recites "0%, 0.36%, 10% and 20% of the malt flour", which is interpreted as any cereal malt flour.

3. Further, while the specification supports using 20% malt flour (second embodiment), there is no support for using "20% or more" as presently recited in claim

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4. While the specification supports incorporating 0-20% malt flour, there is no support for "10% or more", as recited in claim 5, which could encompass any value above 10%.

5. Claims 5-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Since malted cereal flour contains active enzymes, incorporation of active malted flour into the dough at weight percentages as presently claimed will cause a soggy, sticky dough which may not be suitable for baking purposes. The specification is not enabling for incorporating such a high level of active malted cereal grain in the dough. Therefore, undue experimentation is inevitable. For these reasons, the specification does not enable a person skilled in the art to practice the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 5-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jodlbauer (US 6,120,808; hereinafter R1).

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2. R1 discloses a method for producing a flour consisting of two flours. One of these flours is prepared by soaking wheat grains in water, followed by germination of the soaked grains and drying followed by grinding the germinated material. (Abstract)

3. R1 discloses the details of the softening phase (soaking in water), germination phase and drying phase. (Col. 3, lines 15-55). Given the malting process, it is clear that a malted cereal flour is being used in the baking process.

4. R1 discloses the incorporation of the malted wheat grains into regular flour for baking purposes. (Col. 4, Example 1, and 2)

5. Based upon the fact that the reference discloses all of the claimed components in a process for making malted grains, it would be expected that the malting enzymes and disclosed composition would necessarily provide the oligosaccharides as presently claimed, i.e., the malt prepared by the method as disclosed by R1 will intrinsically contain oligosaccharides.

6. While R1 is silent regarding the weight percent of the malt and the flour to which it is added, it is obvious that the oligosaccharide content of the food can be adjusted by changing the weight percent of the malted grain to the food to which it is added. It is also obvious that the concentration of malt enzymes and the oligosaccharides contained therein, would increase in the dough and resulting bread as the weight percent of malt flour is increased in the dough formulation.

7. Given that malting will activate the natural enzymes such as α -amylase in the grain and given that the action of α -amylase on starch will generate oligosaccharides,

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the products of the enzymatic hydrolysis will intrinsically include the oligosaccharides as presently claimed.

8. It is noted that R1 does not disclose using barley malt flour, however, since the use of barley malt flour in bread baking is known in the art, it would be obvious, to an artisan, to incorporate barely malt flour into the bread. Barley malt flour is known in bread baking for containing natural enzymes as well as the pleasant flavor it contributes to the baked product.

9. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to prepare a cereal grain malt and incorporate it into foods as taught by R1. One would do so to incorporate natural enzymes and some oligosaccharides into foods for various purposes. Absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in preparing cereal grain malt and incorporate it into foods.

10. Claims 5-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-2002-095443; Machine Translation, hereinafter R2.

11. R2 discloses malting of black wheat grain [0007]. R2 also disclose the process of drying and grinding the black wheat malt. [0008]. R2 then prepares drinks or baked goods in which the black wheat malt has been incorporated. [0009]

12. Based upon the fact that the reference discloses all of the claimed components in a process for making malted grains, it would be expected that the malting enzymes and disclosed composition would necessarily provide the oligosaccharides as presently

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claimed, i.e., the malt prepared by the method as disclosed by R2 will inherently contain oligosaccharides.

13. While R2 is silent regarding the mixing ratio of the malt and the food to which it is added, it is obvious that the oligosaccharide content of the food can be adjusted by changing the ratio of the malted grain to the food to which it is added.

14. Given that malting will activate the natural enzymes such as α -amylase in the grain and given that the action of α -amylase on starch will generate oligosaccharides, the products of the enzymatic hydrolysis will intrinsically include the oligosaccharides as presently claimed.

15. It is noted that R2 does not disclose using barley malt flour, however, since the use of barley malt flour in bread baking is known in the art, it would be obvious, to an artisan, to substitute the black wheat malt with barely malt flour in the bread baking process. Use of barley malt flour in bread baking is known in the art for containing natural enzymes as well as the pleasant flavor it contributes to the baked product.

16.

17. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to prepare a cereal grain malt and incorporate it into foods as taught by R2. One would do so to incorporate natural enzymes and some oligosaccharides into foods for various purposes. Absent any evidence to contrary and based on the teachings of the cited reference, there would be a reasonable expectation of success in preparing cereal grain malt and incorporate it into foods.

Response to Arguments

Applicants' arguments have been reviewed thoroughly. Due to new grounds of rejection, necessitated by amendments, those arguments are moot.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAMID R. BADR whose telephone number is (571)270-3455. The examiner can normally be reached on M-F, 8:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hamid R Badr
Examiner
Art Unit 1794

/Keith D. Hendricks/

Supervisory Patent Examiner, Art Unit 1794